

REMARKS

Status of the Claims

Claims 11-22 are pending in this application.

Claims 11-22 are rejected.

Rejection of Claims 11-22 Under 35 U.S.C. § 103

Claims 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,538 to Schulz and U.S. Patent No. 5,820,245 to Desmond. The Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claim 11. The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

Independent claim 11 discloses a sensor that is in the mirror housing. By contrast, neither Schulz or Desmond teach, suggest, or motivate one having ordinary skill in the art to place a sensor in the mirror housing. The Office Action references Desmond Col. 4, Lines 37-40 as describing the switches inside the mirror housing. The pertinent part of Desmond states, “[f]urther, the bottom 24 of the case 11 and bezel 12 accommodate lamp assemblies 25, 26 as will be described in more detail below, in addition to switches 27, and 29 for operating the lamp assemblies 25, 26 and a switch 28 for controlling operation of the mirror and the LED 23.” Thus, Desmond is referring to the recesses 48, 49, 50, which are located in the bottom 24 of the case 11 to accommodate the switches 27, 28, 29. Col. 4, Lines 56-57. Desmond is not teaching, suggesting, or motivating one having ordinary skill in the art to place the switches in the mirror housing, but is disclosing a way for the switches to be located on the exterior of the mirror housing and connected to the internal circuitry. Therefore, the user can activate the switch by physically contacting the switch. This differs from the present invention which discloses the switching mechanism inside the mirror housing, since the switch does not need to be physically contacted in order to be activated. Therefore, the Applicant respectfully submits that Desmond does not teach, suggest, or motivate one having ordinary skill in the art to place the switches in the mirror housing, and therefore, independent claim 11 is not obvious and requests removal of the rejection.

Furthermore, the Office Action states that Mr. Zipf's affidavit is insufficient because it fails to provide facts or any rationale for the non-obvious opinion. The Applicant respectfully maintains that the basis for Mr. Zipf's non-obviousness opinion was set forth in the affidavit since he described the prior art and stated his opinion in light of being one having ordinary skill in the art due to his background which was also described in the affidavit.

The combined teachings of the '538 and '245 patents fail to teach, suggest or motivate placing a switching device based upon the approach of a non-metallic object toward a sensor for use in an interior mirror module. Being an individual who is skilled in the area of automotive control devices I profess that the proposed combination of the references would not be obvious. Moreover, one of ordinary skill in the art at the time of the invention was made would not be motivated to place the '538 switch inside a mirror housing.

Zipf's Affidavit, ¶ 10. The Applicant respectfully maintains that since Mr. Zipf was stating his opinion of the prior art being nonobvious based upon being one having ordinary skill in the art, he did state sufficient facts for his opinion. Apparently the Examiner is taking the position that his personal knowledge places the Examiner in a better position to determine obviousness than a signed affidavit of a person skilled in the art. The Applicant maintains that the Examiner's prima facie case of obviousness has been over come with this affidavit evidence. Therefore, the Applicant respectfully maintains that Mr. Zipf's affidavit is sufficient to overcome the Office Action's claim that one having ordinary skill in the art would find it obvious to combine Schulz and Desmond. Thus, the Applicant respectfully request that the Examiner reconsider removal of the rejection.

Moreover, claims 12-22 are dependent or ultimately dependent upon independent claim 11, and therefore contain all of the limitations of claim 11. Therefore, the Applicant respectfully maintains that claims 12-22 are not obvious in view of Schulz and Desmond, and request the removal of the rejection for claims 12-22.

In view of the foregoing, the Applicant respectfully submits that claim 11 is patentably distinguishable over the art cited by the Examiner and respectfully requests withdrawal of the rejection. Likewise, claims 12-22, which depend from claim 11, further define the invention and define over the art cited by the Examiner. Applicant respectfully requests reconsideration and withdrawal of the rejection.

CONCLUSION

It is respectfully submitted that in view of the above remarks the claims 11-22, as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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